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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,962	09/30/2003	David F. Bantz	YOR920030325US1 (16872)	5304
23389 7590 08/29/2008 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER LIU, LIN	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/674,962	Applicant(s) BANTZ ET AL.	
	Examiner LIN LIU	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is responsive to communications filed on 06/12/2008.

Claims 1-12 and 14-30 are pending and have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 2, 4, 6-10, 12-14, 17-21 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ishiyama et al. (Publication no.: US 2005/0102415 A1)** in view of **Zhu et al. (PGPUB. No.: US 2003/0167339 A1)** and **Patel et al. (Patent no.: US 7,149,778 B1)**.

With respect to **claim 1**, Ishiyama teaches a method implemented by a computing device for real-time dynamic switching between a first service provider

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providing a Web-based service for users at a user's computer device over a communications network and a second service provider adapted for providing said service for users at a user's computer device (Ishiyama: fig. 1), said method comprising the steps of:

automatically monitoring said communications network for determining compliance of service-level guarantees according to a switching criterion by said first service provider at said user's computer device (Ishiyama: page 5, paragraphs 64, 66 & 68, noted that the router R1 monitors and checks on the connectivities with ISPa and ISPb), said monitoring including accessing internal functioning of a service that is currently in use (Ishiyama: page 5, paragraphs 64 & 66, noted that the monitoring including periodically checking the connectivities with the ISP(s) that's in use); and,

upon determining non-compliance of said service-level guarantees, locating a second service provider for providing said service according to said service-level guarantees (Ishiyama: page 6, paragraphs 82 and 89-91, noted that when router R1 detects that the primary ISP is disconnected, it sends a message to the communication node N, and the communication node N generates the source address of the new ISP and attaches this address to the header of the packet);

transferring state information associated with said user's use of said service provided by said first service provider at said user's computer device (Ishiyama: page 4, paragraph 50, and page 7, paragraphs 103-105, noted that the connectivity maintains when switching over to the secondary ISP);

terminating provision of said service provided by said first service provider (Ishiyama: page 6, paragraphs 82 and 89-91, noted that the connection with the primary ISPa is disconnected); and

switching service provision to said user's computer device from said second service provider over said communications network (Ishiyama: page 6, paragraphs 82 and 89-91, noted that the service is switched over to the secondary ISPb); and,

migrating said state information maintained up to the time of switching to said service provided by said second service provider, wherein the switching occurs in a manner substantially transparent to the user (Ishiyama, page 7, paragraphs 103-105, noted that the router R1 facilitates the switching of the ISP with node N without interrupting the connectivity), wherein said switching criterion includes one or more selected from the group comprising: the relative usability of a user interface provided at computer device, the relative cost of the service provided by said second service provider as compared to a cost of the service provided by first service provider (Ishiyama, page 5, paragraph 62, noted the fee), a relative cognitive load of a user (Ishiyama, page 5, paragraph 62, noted the transfer speed), and a relative security of said service provided by said second service as compared to the service provided by first service provider.

However, Ishiyama does not explicitly teach a method of replicating state information associated with user's use of service provided by a service provider at user's computer device and a method of correlating criteria on which the switching service provision is based on the relative prevalence of advertisements or SPAM.

In the same field of endeavor, Zhu teaches a method of replicating session information associated with user's use with service provider (Zhu: fig. 15, page 7, paragraph 96).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of replicating session information as taught by Zhu in Ishiyama's invention in order to keep the client's current session information so that when client switches over to the secondary service provider, it is not necessary to begin the session all over again to complete the desired interaction.

However, the combined method of Ishiyama-Zhu does not explicitly teach a method of correlating criteria on which the switching service provision is based on the relative prevalence of advertisements or SPAM.

In the same field of endeavor, Patel teaches a method of correlating criteria on which the switching service provision is based on the relative prevalence of advertisements or SPAM (Patel: col. 1, lines 33-41, noted that user's ISP is switched to another ISP to prevent unsolicited e-mail.).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of switching from one ISP to another ISP to prevent unsolicited e-mail as taught by Patel in the combined method of Ishiyama-Zhu's invention in order to keep user's work uninterrupted, and maintain user's e-mail account clear and save user's e-mail space for other important messages.

With respect to **claim 2**, Ishiyama teaches the method of claim 1, further including the steps of:

maintaining state information associated with said user's use of said service provided by said first service provider (Ishiyama, page 4, paragraph 50, noted the ISP state management unit 34).

With respect to **claim 4**, Ishiyama teaches the method of claim 1, wherein said switching is performed automatically without user knowledge (Ishiyama, page 7, paragraphs 103-105, noted that the router R1 facilitates the switching of the ISP with node N without interrupting the connectivity).

With respect to **claim 6**, Ishiyama teaches the method of claim 1, wherein said user includes: an individual (Ishiyama, page 4, paragraph 47, noted that node N may be a user), or a group of individuals.

With respect to **claim 7**, Ishiyama teaches the method of claim 1, wherein said service provided to said users over a communications network includes a service provisioning one or more of: text, multimedia content, images, broadcasts, recipes, functions for a computer (Ishiyama, page 3, paragraph 41, enabling communication between server S on the internet and communication node N), and sensory stimulations.

With respect to **claim 8**, Ishiyama teaches the method of claim 1, wherein the switching includes transfer of service properties (Ishiyama, page 7, paragraph 103, noted the same destination address).

With respect to **claim 9**, Ishiyama teaches the method of claim 1, wherein the first and second services are Web services, a service provided by the switching provider including a Web service (Ishiyama, page 3, paragraph 40, noted that ISPa and ISPb).

With respect to **claim 10**, Ishiyama teaches the method of claim 1, where a switching criterion includes one or more selected from the group comprising: said first service provider is unavailable (Ishiyama, page 5, paragraph 64, noted that ISP is unavailable); the service provided by first service provider is degraded (Ishiyama, page 6, paragraph 82, ISPa is disconnected).

With respect to **claim 12**, Ishiyama teaches the method of claim 1, where a switching criterion is determined based on a potential or predicted relative liability for providing said service (Ishiyama, page 5, paragraph 62, transfer speed).

With respect to **claim 14**, Ishiyama teaches the method of claim 1 where the switching provider comprises one selected from the group comprising: a third party (Ishiyama, fig. 1, router R1), a provider of the first service, a provider of the second service, a provider of both services, a software agent running on the user's computer, a service provider, a company, the government, a video or image content provider, an audio content provider, an insurance agency, a health care provider, an advertiser, a multimedia broadcaster or cable TV company, a game provider.

With respect to **claim 17**, Ishiyama teaches the method of claim 1, where the switching service in a peer-to-peer file sharing system (Ishiyama, fig. 1, Node N and Server S).

With regard to **claim 18** the limitations of this claim are substantially the same as those in claim 1. Therefore the same rationale for rejecting claim 1 is used to reject claim 18. By this rationale **claim 18** is rejected.

With regard to **claim 19** the limitations of this claim are substantially the same as those in claim 2. Therefore the same rationale for rejecting claim 2 is used to reject claim 19. By this rationale **claim 19** is rejected.

With regard to **claim 21** the limitations of this claim are substantially the same as those in claim 4. Therefore the same rationale for rejecting claim 4 is used to reject claim 21. By this rationale **claim 21** is rejected.

With regard to **claim 23** the limitations of this claim are substantially the same as those in claim 6. Therefore the same rationale for rejecting claim 6 is used to reject claim 23. By this rationale **claim 23** is rejected.

With regard to **claim 24** the limitations of this claim are substantially the same as those in claim 7. Therefore the same rationale for rejecting claim 7 is used to reject claim 24. By this rationale **claim 24** is rejected.

With regard to **claim 25** the limitations of this claim are substantially the same as those in claim 8. Therefore the same rationale for rejecting claim 8 is used to reject claim 25. By this rationale **claim 25** is rejected.

With regard to **claim 26** the limitations of this claim are substantially the same as those in claim 9. Therefore the same rationale for rejecting claim 9 is used to reject claim 26. By this rationale **claim 26** is rejected.

With respect to **claim 27**, Ishiyama teaches the system of claim 18, where a switching criterion includes one or more selected from the group comprising: said first service provider is unavailable (Ishiyama, page 5, paragraph 64, noted that ISP is

unavailable); and the service provided by first service provider is degraded (Ishiyama, page 6, paragraph 82, ISPa is disconnected).

With regard to **claim 28** the limitations of this claim are substantially the same as those in claim 14. Therefore the same rationale for rejecting claim 14 is used to reject claim 28. By this rationale **claim 28** is rejected.

5. Claims 3 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ishiyama et al. (Publication no.: US 2005/0102415 A1)** in view of **Zhu et al. (PGPUB. No.: US 2003/0167339 A1)** and **Patel et al. (Patent no.: US 7,149,778 B1)** and further in view of **Ito et al. (Publication no.: US 2003/0036921 A1)**.

With respect to **claim 3**, Ishiyama teaches the method of claim 1, further including the steps of:

establishing criterion for determining service fees (Ishiyama, page 5, paragraph 62, fee) to be charged by a switching service provider for providing said automatic switching (Ishiyama, page 7, paragraphs 103-105, noted that the router R1 facilitates the switching of the ISP with node N without interrupting the connectivity). However, the combined method of Ishiyama-Zhu-Patel does not explicitly teach a method of communicating fee information to said user.

In the same field of endeavor, Ito teaches a method of communicating fee information to said user (Ito, page 3, paragraph 48, noted that the service fee is displayed to the user).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of displaying the service fee to the user as taught by Ito in the combined method of Ishiyama-Zhu-Patel's invention in order to create a friendly interface to the users with the new service provider.

With regard to **claim 20** the limitations of this claim are substantially the same as those in claim 3. Therefore the same rationale for rejecting claim 3 is used to reject claim 20. By this rationale **claim 20** is rejected.

6. **Claims 5 and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ishiyama et al. (Publication no.: US 2005/0102415 A1)** in view of **Zhu et al. (PGPUB. No.: US 2003/0167339 A1)** and **Patel et al. (Patent no.: US 7,149,778 B1)** and further in view of Official Notice.

With respect to **claim 5**, Ishiyama teaches a method of automatically performing the switching without the knowledge of the user (Ishiyama, page 7, paragraphs 103-105, noted that the router R1 facilitates the switching of the ISP with node N without interrupting the connectivity). Ishiyama failed to disclose a method of performing the switching at behest of a user. Official Notice is taken that a user interface was well known in a server computer to one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of displaying a user interface to the user for entering a command. The advantage of incorporating this method is to notify the user the change of the service provider and the service fee, thus the user will not be over paying for the service fee.

With regard to **claim 22** the limitations of this claim are substantially the same as those in claim 5. Therefore the same rationale for rejecting claim 5 is used to reject claim 22. By this rationale **claim 22** is rejected.

7. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ishiyama et al. (Publication no.: US 2005/0102415 A1)** in view of **Zhu et al. (PGPUB. No.: US 2003/0167339 A1)** and **Patel et al. (Patent no.: US 7,149,778 B1)** and further in view of **O'Brien (Patent no.: US 6,587,831 B1)**.

With respect to **claim 11**, the combined method of Ishiyama-Zhu-Patel teaches all the claimed limitations except that they do not explicitly teach a method of determining a criterion based on a result of an auction system.

In the same field of endeavor, O'Brien teaches a method of determining a criterion based on a result of an auction system (O'Brien, col. 8, lines 2-16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of determining a criterion based on a result of an auction system as taught by O'Brien in the combined method of Ishiyama-Zhu-Patel's invention in as a design pattern for the filter criteria of the switching service.

8. **Claims 15, 16, 29 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ishiyama et al. (Publication no.: US 2005/0102415 A1)** in view of **Zhu et al. (PGPUB. No.: US 2003/0167339 A1)** and **Patel et al. (Patent no.: US**

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7,149,778 B1) and further in view of **Frengut et al. (publication no.: US 2002/0046099 A1)**.

With respect to **claims 15 and 16**, the combined method of Ishiyama-Zhu-Patel teaches all the claimed limitations except that they do not explicitly teach a method of generating a fee for switching services based on user satisfaction level. Wherein determining a user satisfaction level according to biometrics obtained from and concerning the user.

In the same field of endeavor, Frengut teaches a method of generating a fee for switching services based on user satisfaction level. Wherein determining a user satisfaction level according to biometrics obtained from and concerning the user (Frengut, page 2, paragraph 26, noted that the service fee is charged after the user is satisfied with user's preference).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of generating a service fee based on the user's preference and satisfaction as taught by Frengut in the combined method of Ishiyama-Zhu-Patel's invention in order to present a dynamic and customizable interface to the user.

With regard **claims 29 and 30** the limitations of these claims are substantially the same as those in claims 15 and 16. Therefore the same rationale for rejecting claims 15 and 16 is used to reject claim 29 and 30. By this rationale claims 29 and 30 are rejected.

Response to Arguments

9. Applicant's arguments filed on 06/12/2008, with respect to the 35 U.S.C. §112 rejections have been fully considered and are persuasive in view of the amendment. The rejection has been withdrawn.

10. Applicant's arguments filed on 06/12/2008 with respect to the 35 U.S.C. § 103 rejections have been fully considered but they are not persuasive.

11. After carefully reviewing the Applicant's remarks, the following is a list of Applicant's main concerns on the previous Office Action:

a. On page 10 of Applicant's remark, Applicant argues that "However, these cited paragraphs concern only connectivity and not internal functioning as the Claims 1 and 18 currently set forth. Connectivity can be affected by many problems, including a failure of the communications network between the router and the ISP. Thus, it is respectfully submitted that the Examiner's asserting that monitoring connectivity is equivalent to monitoring internal functioning is incorrect."

b. On page 11, 1st paragraph of Applicant's remark, Applicant argues that "The difference between a service-level guarantee and connectivity alone is that connectivity is binary: either a device is connected, or it is not. The more general concern of service-level guarantees is quantitative: for example, if a response time rises above a certain threshold, then the service-level guarantee can be said not to be met.".

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- c. On page 11, 2nd paragraph of Applicant's remark, Applicant argues that "From a reading Ishiyama appears to teach that only the state information present on the user's computer device is maintained in Ishiyama. However, the state information present at the switched-from ISP is not transferred to the switched-to ISP and is not maintained."
- d. On page 11, 3rd paragraph of Applicant's remark, Applicant argues that "the examiner appears to believe that the service provided by the switched-from ISP is terminated in Ishiyama. Respectfully, this is not the case as there appears no teaching nor suggestion of a mechanism in Ishiyama to notify the switched-from ISP that its service is to be terminated. Thus, its service is continued, but without connectivity to the client".
- e. On page 12, 1st paragraph of Applicant's remark, Applicant argues that "Ishiyama is not concerned with switching criteria but rather the choice of an initial connection. This is confirmed by Ishiyama's use of the word "selection" in distinction to switching. Thus, the cited paragraph does not read on switching criterion as now claimed in amended Claims 1 and 18".
- f. On page 12, 2nd paragraph of Applicant's remark, Applicant argues that "The topology of Zhu's system, however, does not match the topology assumed by Ishiyama ... and thus combining the two systems would not be obvious to one skilled in the art".
- g. On page 12, 3rd paragraph of Applicant's remark, Applicant argues that "the examiner cites Patel, who is merely observing that users sometimes do

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switch ISPs to use an email address that is not as widely known to spammers.

This is an observation, not a teaching, and it concerns switching at the discretion of the user, not automatic transparent switching, which is the goal of the present invention”.

h. On page 13, 2nd paragraph of Applicant’s remark, Applicant argues that “the examiner cites Ishiyama paragraph [0050] in which Ishiyama describes an "ISP state management unit 34" for "managing a state of a target ISP." Note that this unit in fact manages a state of the router, not of the ISP: it is the router's view of the connectivity to a particular ISP that concerns Ishiyama. Claims 1 and 18, as amended, concerns a state of the ISP, such as its current responsiveness, the level of service it guarantees, and many other such components of ISP state”.

i. On page 13, 3rd paragraph of Applicant’s remark, Applicant argues that “While some might consider the destination address to be a service property, the thrust of the present invention is not directed to such trivial service properties, which are easily transferred; but rather concerned with service properties that in current practice are exquisitely visible to end users.” And further argues that “the term "service properties" is substantially different from another use of the same term to refer to the service destination address which is, after all, hidden from the end user by the domain name service”.

j. On page 14, 1st paragraph of Applicant’s remark, Applicant argues that “the examiner uses Ishiyama's teaching of the provision of Internet access

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services as allegedly teaching the claim's recitation of Web Services. Web Services are a much higher-level construct than "Internet access."".

k. On page 14, 2nd paragraph of Applicant's remark, Applicant argues that "the Examiner uses Ishiyama's teaching of an example of a disconnected ISP as one in which the service is degraded. However, an ISP's service can be degraded without disconnection. Thus the terms "degraded" and "disconnected" are not equivalent. The present application is thus usable in a broader range of environments ".

l. On page 14, 4th paragraph of Applicant's remark, Applicant argues that "applicant's respectfully fail to see where Ishiyama describes a switching provider at all. The switching provider is the owner and manager of ishiyama's router, and there are many business models and entities who might find switching services advantageous as a business offering".

m. On page 14, 6th paragraph of Applicant's remark, Applicant argues that "the examiner rejects claims 3 and 20, citing Ishiyama's use of the word "fee" in paragraph [0062]. Applicants note that Ishiyama is addressing selecting an initial connection, not providing a switching criterion".

n. On page 15, 1st paragraph of Applicant's remark, Applicant argues that "The passage cited in Frengut at page 2, paragraph [0026] concerns an attempt by a system to meet certain preferences and selection criteria, and not to assess user satisfaction levels and certainly not to do this using biometric means".

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12. In response to applicant's argument **a**, the examiner respectfully disagrees. It appears that applicant has a specific definition of "internal functioning of a service", which has not been included in the present claims. Therefore, the claims are interpreted by the examiner as broadly as reasonable in light of the specification. In the instant case of Ishiyama, the examiner reasonably interprets such term as periodically monitoring of connectivities with the ISPs and *updates* the content when there is a change in the connectivity (Ishiyama: page 5, paragraphs 64 & 66), noted that one of ordinary skill in the art at the time of the invention would realize that updating a content requires *accessing internal functioning of a service*.

13. In response to applicant's argument **b**, the examiner respectfully disagrees, it is noted that the features upon which applicant relies (i.e: quantitative service-level guarantee whether by measuring the bandwidth and latency of the communication...) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

14. In response to applicant's argument **c**, the examiner respectfully disagrees. The presently recited claim language only requires that "state information *associated* with said user's use" to be transferred to the switched-to ISP. Similarly, the examiner interprets the "state information associated with said user's use" as the connectivity used by the user with the primary ISP, wherein this connectivity is transfer/migrate to the secondary ISP without any interruption (Ishiyama: page 4, paragraph 50, page 7, paragraphs 103-105).

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15. In response to applicant's argument **d**, the examiner respectfully disagrees. It is to examiner's knowledge that the presently recited claim only requires "terminating provision of said service", the claim language does not explicitly require "terminating the program's *agreement* with the first service" as illustrated in the specification. Therefore, one of ordinary skill in the art at the time of the invention would realize that terminating a service is equivalent to terminating a connection between the client and ISP (Ishiyama: page 6, paragraphs 82 and 89-91), it does not necessarily have to be terminating of an agreement/contract of the service as described in the specification. Applicant is reminded that the claims are interpreted by the examiner as broadly as reasonable in light of the specification.

16. In response to applicant's argument **e**, the examiner respectfully disagrees. Although the prior art of record does not use the same language as the instant application, it still discloses the same functionality. In specific, one of ordinary skill in the art at the time of the invention would realize that switching an ISP to another ISP encompasses the act of selecting based on a criterion. In the instant case, Ishiyama teaches switching or selecting an ISP based on a fee or transfer speed (Ishiyama: page 5, paragraph 62). Whether switching or selection is done initially or on the fly is irrelevant to the claims as the claims do not positively recite such limitation. In addition, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., switching service provider in real-time) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification

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are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

17. In response to applicant's argument **f**, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

18. In addition, the Supreme Court has held that "a patent for a combination which only unites old elements with no change in their respective functions...obviously withdraws what is already known into the field of its monopoly and diminishes resources available to skillful men...The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745, (U.S. 2007). Furthermore, "Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle...the fact that a combination was obvious to try might show that it was obvious under section 103." *KSR Int'l Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745, (U.S. 2007).

19. When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from

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such an arrangement, the combination is obvious. *Sakraida v. AG Pro, Inc.*, 425 U.S. 273 (1976).

20. In response to applicant's argument **g**, that Patel is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In the instant case, Applicant argues that "Patel is merely observing that users sometimes do switch ISPs to use an email address that is not as widely known to spammers." is an observation, not a teaching. The examiner respectfully disagrees. Whether it's an observation or teaching, the prior art of record discloses such limitation. In addition, Applicant further argued that the switching is not done automatically, the examiner would like to address to the Applicant that the Court has found that providing an automatic or mechanical means to replace a manual activity would accomplish the same result and thus it is not sufficient to distinguish over the prior art (See MPEP 2144.04 Section III, Automating a Manual Activity).

21. In response to applicant's argument **h**, the examiner respectfully disagrees. Although the prior art of record does not use the same language as the instant application, it still discloses the same functionality. In specific, again the presently recited claim language only requires that "state information *associated* with said user's use", it does not explicitly recited "state information of a service provider". Therefore, in the instant case, the association of state information with a user can be the router's view

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of the connectivity to a particular ISP maintained at state management unit 34 of Ishiyama (Ishiyama: fig. 2, page 4, paragraph 50). Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., its current responsiveness) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

22. In response to applicant's argument **i**, the examiner respectfully disagrees. It appears that applicant has a specific definition of "service properties", which has not been included in the present claims. Therefore, the claims are interpreted by the examiner as broadly as reasonable in light of the specification. In the instant case of Ishiyama, the examiner reasonably interprets such term as destination address in Ishiyama (Ishiyama: page 7, paragraph 103). Furthermore, the examiner acknowledges that the thrust of the present invention is not directed to such trivial service properties as illustrated in the specification, however, the presently recited claims do not include such limitations. If Applicant believes that the main inventive features of instant application are illustrated in the specification, but not in the claims, Applicant is advised to include such limitations in the claims.

23. In response to applicant's argument **j**, the examiner respectfully disagrees. It appears that applicant has a specific definition of "web service", which has not been included in the present claims. Therefore, the claims are interpreted by the examiner as broadly as reasonable in light of the specification. In the instant case of Ishiyama, the

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examiner reasonably interprets such term as Internet service in Ishiyama (Ishiyama: fig. 1, page 3, paragraph 40).

24. In response to applicant's argument **k**, the examiner respectfully disagrees. It appears that applicant has a specific definition of "degraded", which has not been included in the present claims. Therefore, the claims are interpreted by the examiner as broadly as reasonable in light of the specification. In the instant case of Ishiyama, the examiner reasonably equates such term as disconnected ISP in Ishiyama (Ishiyama, page 6, paragraph 82, ISPa is disconnected). In addition, Applicant has also admitted in the argument that "an ISP's service can be degraded without disconnection", which means that *an ISP's service can also be degraded to a point of disconnection*.

Furthermore, the present claim language of claim 10 requires that the "switching criterion includes one or more selected from the group". The Examiner submits that the "based on one or more" phrase is an alternative claim language and simply requires that the determination is made on the basis of EITHER one of the conditions recited. In the instant case, Ishiyama also teaches "said first service provider is unavailable" (Ishiyama, page 5, paragraph 64, noted that ISP is unavailable).

25. In response to applicant's argument **l**, the examiner respectfully disagrees. The router disclosed in Ishiyama does not have to be an actual ROUTER DEVICE itself, it can be a computer as disclosed in Ishiyama in page 4, paragraph 52.

26. In response to applicant's argument **m**, see response to argument **e** above.

27. In response to applicant's argument **n**, the examiner respectfully disagrees. It appears that applicant has a specific definition of "satisfaction level", which has not

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been included in the present claims. Therefore, the claims are interpreted by the examiner as broadly as reasonable in light of the specification. In the instant case of Frengut, the examiner reasonably equates such term as the service fee paid by the user after the user is satisfied with user's preferences (Frengut, page 2, paragraph 26).

Conclusion

28. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Liu whose telephone number is (571) 270-1447. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. L./

/Lin Liu/
Examiner, Art Unit 2145

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145